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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,201	01/03/2006	Rolf Moors	TF94-22911/A/PFE 315/PCT	6473
324	7590	05/19/2009	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			NGUYEN, VU ANH	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			05/19/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

andrea.dececchis@ciba.com
deborah.pinori@ciba.com
sonny.nkansa@basf.com

Office Action Summary

Application No.

10/563,201

Applicant(s)

MOORS ET AL.

Examiner

Vu Nguyen

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. Acknowledgement is made of the Amendment filed 04/14/2009, wherein claim 1 and 3 have been amended and new claim 10 has been added. Claims 1-10 are pending in this application.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The disclosure is objected to because of the following informalities: The term "diisocyanate" is often mis-spelled as "diisocyanat" in the examples.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dirschl et al. (US 6,080,830) in view of Wamprecht et al. (US 2003/0065088) for the reasons set forth in the Office action dated 10/15/2008.

Allowable Subject Matter

6. Claim 10 is allowed.
7. The following is an examiner's statement of reasons for allowance: This claim is allowable over the closest prior art references Dirschl et al. (US 6,080,830) and Dirschl et al. (US 6,387,999). The first reference teaches a method similar to the claimed method as discussed in the rejection set forth above. However, it fails to teach a method involving the claimed mixture of isocyanate components. The second reference teaches a fiber-treating composition comprising an ester component A, a polyisocyanate component B, an acrylic polymer component C, and a component D which is a diisocyanate or a polyisocyanate. The component D may be viewed as the claimed polymeric isocyanate and the component B may be viewed as the claimed alicyclic isocyanate. However, the reference fails to teach the claimed method.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

8. Applicant's arguments filed 04/14/2009 have been fully considered but they are not persuasive.

9. The examiner stated in the Office action that "[**Motivations**] Wamprecht also teaches that, due to the incorporation of the hydrophobic monoalcohols [0009], the disclosed polyurethane thickener has improved effectiveness in high-shear range compared to conventional polyurethane thickeners and does not require use of volatile solvents [0006-0009], and that it is particularly suitable for use in processes involving high-shear rates such as coatings by brushes or rollers and spraying [0006]." The applicant alleges that the cited improvements are not a direct consequence of the incorporation of the monohydric alcohol (Remarks, p. 7). The reference clearly attributes those improvements to the incorporation of the **hydrophobic** monoalcohol in paragraph [0007]. Since these improvements are related to the incorporation of hydrophobic segments and since the disclosed ethers are hydrophilic [0078-0079], the improvements are a direct consequence of the incorporation of the monohydric alcohol.

10. In response to applicant's argument that Wamprecht is nonanalogous art (Remarks, p. 7), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference is highly related to the field of applicant's endeavor. The instant application is directed to an aqueous polyurethane dispersion for treating fiber materials. The reference is directed to an aqueous polyurethane dispersion which is effective at adjusting the rheological properties of aqueous

formulations employed in applications that include textile dyes [0005] as well as in treating fiber materials such as leather and paper [0068].

11. As to applicant's claim of the criticality and unexpected results of the successive steps recited in claim 1 by comparing the inventive examples 1-3 against the comparative example 4 (Remarks, p. 8), such claim lacks support because example 4 does not have blocking agent and consequently it cannot be used to compare against examples 1-3 to show the criticality of the recited successive steps.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu Nguyen whose telephone number is (571)270-5454. The examiner can normally be reached on M-F 7:30-5:00 (Alternating Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Nguyen
Examiner
Art Unit 1796

/David Wu/
Supervisory Patent Examiner, Art Unit 1796